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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/700,287	11/03/2003	Rodney Carl Harris	10016459-1	4508
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EXAMINER

WILLS, LAWRENCE E

ART UNIT	PAPER NUMBER
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2609

MAIL DATE	DELIVERY MODE
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07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/700,287

Applicant(s)

HARRIS ET AL.

Examiner

Lawrence E. Wills

Art Unit

2609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26-28, 30-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The word logic in these claims are nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3, 5, 10-19**, are rejected under 35 U.S.C. 102(e) as being anticipated by **Brown et al. (U.S. Patent No. 6,671,805)**.

With regard to claim 1, 17, 30, 35, Brown teaches a method for enabling electronic document ratification comprising: receiving an unmodifiable document 102 with a document receiving device 100; collecting handwritten content from a recipient of the document; and adding data reflective of the handwritten content to the document without replacing original content of the document. (Abstract) Brown also teaches a document sending device 100, comprising: a processing device 202 and memory 212 including a document ratification manager 212. (Figure 2)

With regard to claim 2, 18, 19, Brown teaches a method wherein receiving an unmodifiable document 102 comprises receiving an unmodifiable document with a multi-function peripheral (MFP) device 100. (Figure 2)

With regard to claim 3, Brown teaches a method wherein receiving an unmodifiable document 102 comprises receiving a PDF file. (Column 12, line 29)

With regard to claim 5, Brown teaches a method wherein collecting handwritten content comprises collecting handwritten content from a recipient of the device using the document receiving device. (Column 13, lines 26-27)

With regard to claim 11, 24, 34, and 39 Brown teaches a method wherein adding data comprises adding data within an input block 118 of the unmodifiable document. (Column 8, lines 34-47)

With regard to claim 12, Brown teaches a method further comprising at least one of printing the document after the data has been added, transmitting the document after the data has been added, and storing the document after the data has been

added. (Figure 2 Network Interface 206 and storage device 204, in addition, column 9, lines 31-50, column 13, lines 27-29)

With regard to claims 13-16, 25-29, Brown teaches a document sending device, comprising: a processing device 202 and memory 212 including a document ratification manager 212 that is configured to identify a document to be ratified, add metadata to the document that identifies that the document is to be ratified, add metadata to the document that identifies the location of an input block of the document to which handwritten content is to be added, and transmit the document and metadata to a document receiving device. (Figure 1, To-Be-Signed Tag 116, Digital Signature 118, in addition, column 8, lines 16-59)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 6, 7, 8, 10, 20, 21, 23, 31, 33, 36, and 38** rejected under 35 U.S.C. 103(a) as being unpatentable over **Brown et al. (U.S. Patent No. 6,671,805)** in view of **Iggulden et al. (U.S. Patent No. 4,918,723)**

With regard to claims 6 and 20, Brown teaches a method of collecting handwritten content from a recipient of a document. (Abstract)

Brown does not teach scanning handwritten content.

Iggulden teaches a method of collecting handwritten content comprises scanning handwritten content using the document receiving device. (Figure 11, in addition, column 10, lines 32-36)

At the time when the invention was made, it would have been obvious to one of ordinary skill in the art to include scanner and digitizing pad taught in the Iggulden reference as an input device taught in the Brown reference.

The suggestion/motivation for doing so would have been to simplify the system and to make the digital signature more authentic.

Therefore, it would have been obvious to combine Iggulden with Brown to obtain the invention as specified in claims 6 and 20.

With regard to claims 7 , 21, 31, and 36, Brown teaches a method of collecting handwritten content from a recipient of a document. (Abstract)

Brown does not teach scanning handwritten content.

Iggulden teaches scanning handwritten content comprises only scanning handwritten content that was manually added to a printout of the document. (Figure 11, in addition, column 10, lines 32-36)

At the time when the invention was made, it would have been obvious to one of ordinary skill in the art to include scanner and digitizing pad taught in the Iggulden reference as an input device taught in the Brown reference.

The suggestion/motivation for doing so would have been to simplify the system and to make the digital signature more authentic.

Therefore, it would have been obvious to combine Iggulden with Brown to obtain the invention as specified in claims 7, 21, 31, and 36.

With regard to claim 8, Iggulden teaches a method wherein only scanning handwritten content that was manually added comprises only scanning handwritten content contained within an input block of the document. (Figure 11, in addition, column 10, lines 32-36)

With regard to claims 10, 23, 33, and 38, Brown teaches a method/system to collect handwritten data. (Abstract)

Brown does not teach a method wherein collecting handwritten content comprises collecting handwritten marks entered by the recipient in a handwriting input device of the document receiving device.

Iggulden teaches collecting handwritten marks entered by the recipient in a handwriting input device. (Figure 11, in addition, column 10, lines 32-36)

At the time when the invention was made, it would have been obvious to one of ordinary skill in the art to include scanner and digitizing pad taught in the Iggulden reference as an input device taught in the Brown reference.

The suggestion/motivation for doing so would have been to simplify the system and to make the digital signature more authentic.

Therefore, it would have been obvious to combine Iggulden with Brown to obtain the invention as specified in claims 10, 23, 33, and 38.

6. **Claims 4, 9, 22, 32, and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Brown et al. (U.S. Patent No. 6,671,805)** in view of **Adobe Acrobat 4.0 User Guide**.

With regard to claim 4, Brown teaches a method of receiving an unmodifiable document. (Abstract)

Brown does not teach receiving an unmodifiable document comprises receiving a file containing scanned data.

Adobe Acrobat 4.0 User Manual teaches the conversion of any document, including scanned paper documents, to Adobe PDF and enhance it with navigational, security, and annotation features. (Frequently Asked Questions, page 1)

At the time when the invention was made, it would have been obvious to one of ordinary skill in the art to include a file containing scanned data as an unmodifiable document.

The suggestion/motivation for doing so would have been a engineering design choice.

Therefore, it would have been obvious to combine Adobe Acrobat 4.0 User Manual with Brown to obtain the invention as specified in claim 4.

With regard to claim 9, 22, 32, and 37, Adobe Acrobat 4.0 User Guide teaches scanning handwritten content comprises scanning an entire printout of the document and comparing data obtained through the scanning with data of the received unmodifiable document. (Adobe Acrobat 4.0 and Digital Signatures, page 3)

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ainsworth (US Patent No. 7,139,910) and Bisbee (US Patent No. 6, 367, 013)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence E. Wills whose telephone number is 571-270-3145. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on 571-272-7687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEW
July 3, 2007



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